

REMARKS/ARGUMENTS

The Office Action mailed March 27, 2003 has been carefully reviewed. Reconsideration of this application, as amended and in view of the following remarks, is respectfully requested. The claims presented for examination are: claims 2-6, 8-12, 14-22, 28, and 32-35. The Office Action mailed March 27, 2003 was non-final.

35 USC 102 Rejection

In Office Action mailed March 27, 2003, claims 2-6, 8-12, 15-16, 28, and 34-35 were rejected under 35 USC 102 (b) as allegedly being anticipated by Phan et al (US Patent No. 5, 674,242).

All of the independent claims and some of the dependent claims have been amended and now specify "said shape memory polymer comprises a cylinder."

Applicants wish to correct a statement by Applicants' previous attorney, L. E. Carnahan, in the communication (Preliminary Amendment) filed on February 26, 2003. The statement contains a typographical error and Applicants believe it is important to correct the statement. The statement was meant to read, "A helical device does not define a cylinder or a closed tube device." The word "not" was inadvertently left out of the statement. It is Applicants' position that a helical device does not define a cylinder or a closed tube device.

Applicant respectfully submits that the Phan et al reference does not show the structural elements of the claims now presented for examination. As stated in Verdegaal Bros. v. Union Oil Co. of California, 814 F.2nd 628, 631 USPQ 1051, 1053 (Fed. Cir. 1987), "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." Since the structural elements of the claims now presented for

examination are not shown by the Phan et al reference, the rejection is unsupported by the art and should be withdrawn.

35 USC 103 Rejections

Claims 14 and 17-22 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Phan et al in view of Maynard (US Patent No. 5,405,337). Applicants have amended all of the independent claims and some of the dependent claims in the subject application. Applicant respectfully traverses the rejection of claims 14 and 17-22 under 35 U.S.C. §103. The cited Phan et al reference does not show the structural elements of claims 14 and 17-22 as argued above. The Maynard reference does not show the missing elements. Further, there is no suggestion in the references to form a proper combination of the Phan et al and Maynard references to meet Applicants claimed invention.

Claims 32-33 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Phan et al in view of Lee et al (US Patent No. 6,059,815). Applicants have amended all of the independent claims and some of the dependent claims in the subject application. Applicant respectfully traverses the rejection of claims 32-33 under 35 U.S.C. §103. The cited Phan et al reference does not show the structural elements of claims 32-33 as argued above. The Lee et al reference does not show the missing elements. Further, there is no suggestion in the references to form a proper combination of the Phan et al and Lee et al references to meet Applicants claimed invention.

SUMMARY

The undersigned respectfully submits that, in view of the foregoing amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated March 27, 2003 have been fully addressed and overcome. The present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



Eddie E. Scott
Assistant Laboratory Counsel
University of California
Lawrence Livermore National Laboratory
Attorney for Applicant
Registration No. 25,220
Tel. No. (925) 424-6897

Livermore, California

Dated: June 4, 2003